

**PATENT
ATTY DOCKET NO SAA-49****REMARKS**

In the Office Action dated January 2, 2004, claims 1-28 are pending and have been rejected. Accordingly, claims 1-28 are at issue. By virtue of the present Amendment, claims 1, 18, and 20-22 have been amended to include the limitation that the installation site address is searched by a search mechanism. The support can be found on page 4, lines 15-18 and on page 5, lines 9-17 of the present application. Claim 25 has been amended to change the claim upon which it depends. With these amendments, no new matter has been added.

35 U.S.C. § 112, First paragraph

At section 2 of the office action, claims 10, 11, 12, 23 and 24 are rejected under 35 USC § 112 first paragraph for containing subject matter that is not described in the specification in such a way to enable one skilled in the art to practice the invention. The Examiner states that the specification says only "a search device, such as a web spider, can be coded" but goes into no detail about how this code should work. The Examiner also asserts that a system of searching IP address or MAC addresses close to the address of known pieces of equipment is not well-known in the art.

It is respectfully submitted that the Internet-based search device, such as web spider, is well-known in the art. As described in Newton's Telecom Dictionary, 20th updated and Expanded Edition, 2004, Spider is "a program that prowls the Internet, attempting to locate new, public accessible source such as WWW documents, files available in public FTP archives, and Gopher documents. Also called wanderers or robots (bots), spiders contribute their discoveries to a database, which Internet users can search by using an Internet-accessible search engine." Moreover, by going on the Internet to do a google search under "Internet spider", for example, one can get thousands of items explaining what a web spider is. For example, with the web-site:

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<http://www.tiscali.co.uk/reference/dictionaries/computers/data/m0050936.html>, one can find the following definition: "Program that combs the Internet for new documents such as Web pages and FTP files. Spiders start their work by retrieving a document such as a Web page and then following all the links and references contained in it. They repeat the process with the followed links, supplying all the references they find to a database that can be searched via a search engine."

The present invention is not concerned with the programming of a search engine. Rather, the present invention uses an existing searching tool to search IP addresses over the Internet.

Search techniques are taught in the initial freshman class in programming for either Electrical Engineering or Computer Science college curriculums, and are included in the beginning programming books. The typical audience for this application has a minimum training that includes a college freshman programming class. As such, claims 10-12, 23-24 are clearly understandable to one skilled in the art.

Therefore, applicant requests that the Examiner remove the rejections of claims 10-12, 23 and 24 based upon 35 USC 112 first paragraph.

35 U.S.C. § 112, Second paragraph

At section 4, the Examiner rejects claim 25 under 35 U.S.C. § 112, second paragraph, for lacking antecedent basis regarding the limitation "the searching means" as recited

Applicant has amended claim 25 so that it is dependent from claim 23. No new matter has been introduced. The antecedent support can be found in claim 23.

At section 5, claim 18 is rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out the claimed subject matter. Applicant has amended claim

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18 to particularly point out how the installation site address is searched. No new matter has been introduced.

35 U.S.C. § 103

At section 7, claims 1-9, 13-22 and 26-28 are rejected under 35 U.S.C. § 103 as being anticipated by US Patent No. 5,790,664 ("*Coley*") in view of US Patent No 6,038,486 ("*Saitoh*").

In order for a rejection under 35 U.S.C. § 103 to be proper, each and every limitation specified in the claim must be anticipated. Regarding claims 1 and 20, the Examiner alleges that *Coley* shows a method of monitoring a product via a communication network, wherein the installation site address is associated to the product based on the identifiable information (Col.8, lines 38-42).

It is respectfully submitted that *Coley* discloses a method for determining whether the software is validly licensed based on records of valid licensed stored in a database. The records consist of information provided by the user or supplied by the computer where the software is installed. At col. 8, lines 38-42, *Coley* discloses updating the database using information supplied by the user or the IP address of the computer supplied. When the software is subsequently used, the client module sends a license validity inquiry request message to a license server. If the license record exists in the database, then the software application is enabled to allow the client module to use the software. If not, the software application is disabled if the user does not take appropriate action (see Figure 2; col.9, lines 1-27). In this respect, *Coley* only checks to see whether the "identifiable information" provided by the user or by the user's computer is recorded in the database as a license record. This "identifiable information" alone is used to enable the software application in the client module.

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In contrast, in the claimed invention, the installation site address is searched and the identifiable information is obtained so as to associate the installation site address to the identifiable information. *Coley* does not disclose or even suggest that the installation site address is searched so that the identifiable information can be associated with the installation site address.

For this reason alone, claims 1 and 20 are distinguishable over the cited *Coly* reference.

The Examiner admits that *Coley* fails to disclose that the product is a factory automation product, but points *Saitoh* for showing a factory automation software based product. It is respectfully submitted that *Saitoh* does not disclose or suggest the association of the identifiable information with the installation site address. Thus, *Saitoh* is irrelevant to the claimed invention, whether it is used in connection with the cited *Coley* reference.

For the above reasons, it is respectfully submitted that claims 1 and 20 are distinguishable over the cited *Coley* and *Saitoh* references.

Moreover, the Office Action has failed to provide a motive or incentive as to why it would have been obvious to combine *Coley* with *Saitoh*. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). When the motivation to combine the teachings of the references is not immediately apparent, an explanation is required as to why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). Applicants respectfully submit that because a suggestion or motivation to combine the cited references has not been shown, a prima

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facie case of obviousness has not been made. The mere fact that "A significant amount of software piracy occurs in a commercial setting" is not an incentive to combine, nor is it a roadmap to combine the select elements in the manner suggested. In fact, the present invention concerns an industrial of factory setting, not the commercial setting as in the Examiner's rejection. Furthermore, the teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 2-9, 13-19, 21, 22, and 26-28 are dependent from claims 1 and 20 and recite features not recited in claims 1 or 20. For reasons regarding claims 1 and 20 above, it is respectfully submitted that claims 2-9, 13-19, 21, 22 and 26-28 are also distinguishable over the cited *Coley* and *Saitoh* references.

Conclusion

Applicant has amended claims 1, 18, 20-22 and 25 with this amendment. As amended Claims 1-28 are allowable. Early allowance of all pending claims is earnestly solicited.

The commissioner is authorized to charge deposit account 19-3875 (SAA-49) for any fees associated herein.

Respectfully submitted,

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